

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-24. By this paper, no claims are amended, cancelled or added. Claims 1-24 remain pending in the present application and are believed to be in condition for allowance. In view of the following remarks, the Applicant respectfully requests reconsideration and allowance of all pending claims.

### **Response to Examiner's Note**

In the Office Action, the Examiner asserted that Applicant used non-conventional technical terminologies with regard to the term "a singleton object" in the claims. Particularly, the Examiner stated:

The following non-conventional technical terminologies used in the claim language limit the scope of the claim, which directly or indirectly (by means of a parent claim) refer to the terminologies, to their explicit definitions as disclosed in the application.

--A singleton object: is an object that exists in memory such that only one type of object exists at any time in memory. Once created, a singleton object is not destroyed after use, like most objects, but is kept in memory until accessed again.

Office Action, page 2.

The Examiner further considered the specification of the present application not adequate so as to invoke a 35 U.S.C § 112, 6<sup>th</sup> paragraph interpretation of claim 15. The Examiner stated the following:

The Examiner notes that it appears that the Applicant is attempting to invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph in Claim 15, with the use of means-plus-function language in the claim. As disclosed in the specification of the application, each of the means for performing the steps of the system recited in the claim is constructed by a series of algorithmic steps implemented in software program instructions. Thus, the specification does not provide any specific physical structure for the features that could be read into the claim to limit the scope of the means for the components or steps constituting the

claimed system. Therefore, the Examiner does not consider the specification to be adequate to invoke a 35 U.S.C. 112, 6<sup>th</sup> paragraph interpretation and furthermore, for the purpose of further claim analysis under 35 U.S.C. 102 and 103, the Examiner treats Claim 15 as a computer program containing machine-readable instructions stored on a physical medium for performing the steps recited in the claim.

Office Action, pp. 2, 3.

Applicant respectfully objects to the foregoing Examiner's notes. With regard to the use of non-conventional terminologies, the Examiner is reminded that the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff'd*, 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Therefore, Applicant asserts that the term "a singleton object" is properly described in the specification and recited in the claims.

With regard to the interpretation of claim 15, Applicant submits that the Federal Circuit has endorsed the use of means-plus-function language in the context of software inventions when the specification teaches a correspondence between software and a claimed means-plus-function element. *See Medical Instrumentation and Diagnostics Corp v. Elekta AB*, 68 U.S.P.Q. 2d 1263 (Fed.Cir 2003). In the present application, the figures and descriptions thereof disclose software architectures such as, for example, a model-view-controller MVC 10, configured with a variety of object-oriented programming languages, such as Java by Sun Microsystems, Inc., Santa Clara, California. Application, paragraphs 10, 11; Fig. 1. Hence, Applicant submits that the specification provides the adequate structure so that the Examiner may invoke interpretation of claim 15 under 35 U.S.C § 112, 6<sup>th</sup> paragraph.

### **The Rejection Under § 101**

In the Office Action, the Examiner rejected claims 1 and 15 under 35 U.S.C. §101 because they disclose a claimed invention considered a software program containing machine executable instructions, not associated with any physical structure which renders the claims non statutory under Section 101. Specifically, the Examiner stated:

Claims 1 and 15 (see Examiner's Note above) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

-- As disclosed in the specification of the application, all components recited in the claim that constitute the claimed system are constructed of software program objects and/or instructions. Thus, the claimed system is considered a software program containing machine-executable instructions, per se (and not associated with any physical structure); therefore, it is non-statutory according to 35 U.S.C 101. For the purpose of further claim analysis under 35 U.S.C. 102 and 103, The Examiner treats both Claims 1 and 15 as a computer program containing machine-readable instructions stored on a physical medium for performing the method or steps recited in the claim.

Office Action, p. 3.

The Applicant respectfully asserts that the present claims are directed to statutory subject matter. Any analysis of whether a claim is directed to statutory subject matter begins with the language of 35 U.S.C. § 101, which reads:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In interpreting Section 101, the Supreme Court stated that Congress intended statutory subject matter to "include *anything* under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 U.S.P.Q. 193, 197 (1980) (emphasis added). Although this statement may appear limitless, the Supreme Court has identified three categories of

unpatentable subject matter: laws of nature, natural phenomena, and abstract ideas. *See, Diamond v. Diehr*, 450 U.S. 175, 182, 209 U.S.P.Q. 1, 7 (1981). Accordingly, so long as a claim is not directed to one of the three specific areas listed above, the claim is directed to patentable subject matter. Thus, it is improper to read restrictions into Section 101 regarding subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitation. *In re Alappat*, 31 U.S.P.Q.2d 1545, 1556 (Fed. Cir. 1994) (citing *Chakrabarty* 447 U.S. at 308).

For example, the fact that a claim includes or is directed to an algorithm is no ground for holding a claim is directed to non-statutory subject matter. *See, In re Iwashashi*, 12 U.S.P.Q.2d 1908, 1911 (Fed. Cir 1989). Rather, the proscription against patenting an algorithm, to the extent it still exists, is narrowly limited to *mathematical algorithms in the abstract*, e.g., describing a mathematical algorithm as a procedure for solving a given type of mathematical problem. *See, AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1450 (Fed. Cir 1999). Indeed, the courts are aware that any step-by-step process, be it electronic, chemical, or mechanical, involves an algorithm. *Id.* at 1450.

Thus, inquiry into what is statutory subject matter simply requires “an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a ‘law of nature’ or an ‘abstract idea, or if the mathematical concept has been reduced to some practical application rendering it ‘useful’” *Id.* at 1451 (citing and quoting *In re Alappat*, 31 U.S.P.Q.2d at 1557). Furthermore, a Section 101 analysis “demands that the focus in any statutory subject matter analysis be on the *claim as a whole*.” *In re Alappat*, 31 U.S.P.Q.2d at 1557 (citing *Diehr*, 450 U.S. at 192) (emphasis in original). Indeed, the dispositive inquiry is whether the claim

as a whole is directed to statutory subject matter, it is irrelevant that a claim may contain, as part of the whole, subject matter that would not be patentable by itself. *Id.*

The Applicant respectfully disagrees with the Examiner's assertions and interpretation of the law. Indeed, the Applicant contends that the Examiner's assertion that software inventions are *per se* non-statutory flies in the face of the clear precedent of the Federal Circuit, as set forth above. Additionally, if the Examiner is attempting to apply a "technological arts" test, it is made clear in *Ex Parte Lundgren* that such a test does not exist. *Ex Parte Lundgren*, 76 U.S.P.Q.2d 1385, 1388 (Bd. Pat. App. & Int. 2005). Moreover, the systems recited in independent claims 1 and 15 are clearly useful for "creating web applications" and are fully supported by the specification as set forth above. This is all the law requires in order to comply with Section 101. Applicant accordingly requests withdrawal of the rejection of claims 1 and 15 under Section 101.

### **Claim Rejections Under § 102**

In the Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. § 102(a) as anticipated by Kwong et al. (Building a Portlet within the Model-View Controller Paradigm Using WebSphere® Portal, hereinafter "the Kwong reference"). Specifically, the Examiner stated:

--Claims 1, 8, 15 and 22: Kwong et al. disclose a software program tangibly stored on a machine readable medium containing computer readable instructions for performing the method of creating web applications, the method comprising:

- creating a controller that receives a requests for data from a user and responds to the request by sending information to the user (i.e., a portal and its inherent properties; Page 1); and
- providing a configurator that loads configuration information for use by the controller from a configuration file and stores the configuration information for subsequent access (i.e., a portlet and its specified deployment descriptors and user attributes; Page 2).

--Claims 2, 9, and 16: **Kwong et al.** disclose the method of claim 1 (and 8, 15) and further defining the configuration file to be a text properties configuration file (i.e., the deployment descriptors, portlet.xml and web.xml, of a portlet).

--Claims 3, 10, 17, and 23: **Kwong et al.** disclose the method of claim 1 (and 8, 15, and 22) and further adapting the configurator to store the configuration information as a singleton object (i.e., a specific portlet in a portal; Page 2).

-- Claims 4, 11, and 18: **Kwong et al.** disclose the method of claim 1 (and 8, 15) and further defining the configuration information to comprise error handling information (i.e., defect list and error view; Fig. 3, page 4).

-- Claims 5, 12, and 19: **Kwong et al.** disclose the method of claim 1 (and 8, 15) and further defining the configuration information to comprise log processing information (i.e., graphical display of events; Fig. 6, pages 5 - 8).

-- Claims 6, 13, and 20: **Kwong et al.** disclose the method of claim (and 8, 15) and further defining the configuration information to comprise data that is specific to each of a plurality of portals (i.e., a portlet and its associated sub-objects in a specific portal; Fig. 3, page 4).

-- Claims 7, 14, 21 and 24: **Kwong et al.** disclose the method of claim 1 (and 8, 15, 22) and further adapting the configurator to read the configuration information upon initialization of the controller (i.e., portlet interface initialization, init(); Fig. 3, page 4).

Office Action, pp. 4, 5.

### ***Legal Precedent***

The Applicant respectfully traverses this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of

the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

On a preliminary note, the Applicant stresses that the Examiner's rejections under Section 102 are vague regarding the various claim features and, thus, the Applicant reminds the Examiner of the provision of 37 C.F.R. § 1.104(c)2, which state:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

*See also* M.P.E.P. § 707.07.

Turning now to the claims, for example, independent claims 1 and 22 recite “a controller *generator*...adapted to provide a web application,” and “a configurator *generator*...adapted to provide a configurator that loads configuration information. (emphasis added). Similarly independent claims 8 and 15 recite “creating a controller that is adapted to receive a request,” and “*creating a configurator* that loads configuration information. (emphasis added). Further, as recited by the claims, configuration information is used by the “controller from a configuration file [such that the configurator generator]...stores the configuration information for subsequent use.”

Applicant respectfully submits that the rejection under Section 102 is improper because the prior art reference that is used to reject the claims does not contain each and every element recited by the claims. As quoted above, it appears that the Examiner has interpreted a portal disclosed in the Kwong reference as the recited controller, and a portlet as the recited

configurator. To the extent the Examiner's interpretation is accurate, the Kwong reference clearly does not disclose a controller *generator that operates to produce the controller*, nor does the reference disclose a configurator *generator that operates to produce a configurator*. For example, the Kwong reference discloses retrieving a portlet state from an appropriate attribute object. Kwong, page 1, paragraph 5. However, Kwong does not disclose generating the state, i.e., the configurator as recited by independent claims 1 and 22.

In addition, the Kwong reference does not disclose configuration information used by the controller from a configuration file and such that the configurator generator stores the configuration information for subsequent use, as recited by the claims. Similarly, Kwong does not disclose creating a controller that is adapted to receive a request, and creating a configurator that loads configuration information, as recited by independent claims 8 and 15. Therefore, because the Kwong reference lacks such disclosures it can not anticipate the claimed subject matter of independent claims. Applicant accordingly requests withdrawal of the rejection of claims 1-24 under Section 102 based on Kwong.

#### **Kwong Does Not Anticipate dependent Claims 3, 10, 17 and 23**

Again, as stated above, Applicant submits that the rejections of dependent claims 3, 10, 17 and 23 are vague and unclear. Further, the rejection of the aforementioned claims is improper because the Kwong reference does not disclose each and every element recited by the claims. For example, dependent claims 3, 10, 17 and 23 recite a configurator adapted "to store the *configuration information as a singleton object*." (emphasis added). As appreciated by those of ordinary skill in the art in light of Applicant's disclosure, a singleton object is:

is an object that exists in memory such that only one of that type of object exists at any time in memory. Once created, a singleton object is not



destroyed after use, like most objects, but is kept in memory until accessed again.

Application, paragraph,37.

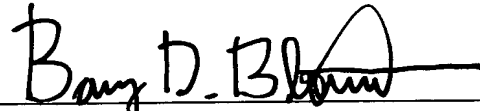
The Kwong reference, does not disclose a singleton object, particularly, not one having properties such as those described above. Therefore, the reference cannot anticipate the subject matter of claims 3, 10, 17 and 23.

Further, in rejecting claims 3, 10, 17 and 23, the Examiner interpreted the recited singleton object as a specific portlet. Office Action, page 4. However, in the above rejection of independent claims 1, 8, 15 and 22, the Examiner interpreted the portlet of the Kwong reference as the configurator generator. Applicant submits that a configurator generator loads data from a configuration file that is stored as a singleton object. *See* Application, paragraph 37. Hence, a configurator generator and a singleton object are two distinct entities. If the Examiner maintains the rejection of independent claims 1, 8, 15 and 22 on the basis of equating a configurator generator to a portlet then based on the foregoing discussion such an equality would not hold in the rejection of dependent claims 3, 10, 17 and 23. Accordingly, the Examiner's rejections of dependent claims 3, 10, 17 and 23 are inconsistent with those of independent claims 1, 8, 15 and 22 and are, therefore, deficient. In light of the foregoing discussion, Applicant requests the Examiner to withdraw the rejection and allow dependent claims 10, 17 and 23.

**Conclusion**

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry D. Blount", written over a horizontal line.

Date: October 31, 2006

Barry D. Blount  
Registration No. 35,069  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545

**HEWLETT-PACKARD COMPANY**

Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400